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PATENT

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J. Cotton
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the U.S. Application of

Paul SIDIKMAN et al.

Group Art Unit: 2164

U.S. Serial No.: 09/006,839

Examiner: Kazimi, H.

Filed: January 12, 1998

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Technology Center 2100

For: METHOD AND SYSTEM FOR PROVIDING INTEGRATED BROKERAGE AND
OTHER FINANCIAL SERVICES THROUGH CUSTOMER ACTIVATED TERMINALS

Commissioner For Patents
Washington, D.C. 20231

RESPONSE

Sir:

This is in full and timely response to the non-final Office Action as mailed on May 8, 2001 (Paper No. 19). Claims 19-37 are currently pending in the present application. Reconsideration of this application is respectfully requested in view of the following remarks.

In the above-mentioned Office Action, the Patent Office (PTO) rejected claims 19-37 under 35 U.S.C. 102(a) based upon a public use or sale as evidenced by the article, "Trade it Yourself Bank Machines Make a Debut Securities," Los Angeles Times, October 6, 1994 (hereinafter referred to as "the cited newswire"). The PTO also requested additional information and documentation under 37 CFR 1.105.

Applicants respectfully thank the Examiner for kindly granting an office interview with Applicants' representative, Tiep Nguyen (Reg. No. 44,465), on October 2, 2001, regarding the above-identified Office Action. Applicants further thank the Examiner for withdrawing the rejection of claims 19-37 under 35 U.S.C. 102(a).

Rejection of claims 19-37 under 35 USC 102(a)

With regard to the rejection of claims 19-37 under 35 USC 102(a), this rejection is now moot in view of the PTO's withdrawal of the rejection during the office interview, as mentioned earlier.

As stated in a previous Response by Applicants and reiterated during the office interview, the cited newswire describes technology purportedly owned by the same assignee of the present invention, i.e., Citibank, N.A. It is respectfully submitted that the cited newswire was released on October 6, 1994, substantially less than one year prior to the priority date of June 7, 1995 of the present application.

Furthermore, it is respectfully submitted that the purported teaching in the cited newswire is sparse and unclear and does not disclose Applicants' invention *as claimed*, which is a requirement for any asserted prior art rejection under 35 U.S.C. 102.

Accordingly, Applicants respectfully submit that claims 19-37 are allowable over the references of record.

Request for Additional information and documentation under 37 CFR 1.105

With regard to the PTO's request for information and documentation under 37 CFR 1.105, it is respectfully submitted that the requested information and documentation are unknown or not readily available. As stated in a previous Response by Applicants and restated here, "it is respectfully submitted that *no evidence has been located* of any prior publication or use that would qualify as prior art under 35 U.S.C. 102(a). While Applicants will make a continued effort during the pendency of this application to bring to the Examiner's attention prior art that may be material to the examination of this case – whether prior art of Citibank, with its vast number of departments and employees, or of another entity."

During a telephone discussion between Applicants' representative, Tiep Nguyen, and the Examiner on October 15, 2001, the Examiner has indicated that the above recited statement is a sufficient response to the requirement for information under 37 CFR 1.105 set

forth by the Examiner. Accordingly, Applicants respectfully submit that the requirement be withdrawn.

Conclusion

For at least all of the above reasons, Applicants respectfully submit that the present invention is neither disclosed nor suggested by the references of record, and the claims now pending patentably distinguish the present invention from the references of record. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone Applicants' undersigned representative at the number listed below.

Respectfully submitted,
Paul SIDIKMAN et al.

Date: 10/17/01

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